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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,163	03/04/2002	Kathleen Hickey Wallis	530057-332	6026

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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,163

Applicant(s)

WALLIS, KATHLEEN HICKEY

Examiner

Jila M. Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 03/27/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 47-48 and 51-55 are rejected under 35 U.S.C. 102(a) as anticipated by
or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blanco (5,839,575).

Blanco '575 discloses a fold open display box (10) for protecting a recorded media (floppy disk 84, compact disk 82), the box comprising: a first section having a planar face, a first cavity (cavity 26), a first interlocking portion (first upstanding quadrilateral wall 28) around the first cavity, and a cutout portion (viewing window 86, see column 3, lines 58-63) in a planar face panel of the first section over the first cavity; and at least partially transparent window attached over the cut out portion of the planar face of the first section; a second section having a second planar face, a second cavity (cavity 22) sized to receive and hold a recorded media therein, and a second interlocking portion (second upstanding wall 58) around the second cavity, wherein the first and second interlocking portions engage (flanges 34A, 34B, 34C and 34D engaging the notches 36A, 36B, 36C and 36D, see column 4, lines 51-58) to maintain the first section in registry with the second section when the fold open box is closed; a toy (booklet which can be construed as a toy) in the first cavity positioned for display through the at least partially transparent window (viewing window 86), wherein a portion of the cut out

portion is shaped to correspond to a shape of at least a portion of the toy (the quadrilateral outer periphery of the cutout corresponds to the quadrilateral outer periphery of the booklet) ; and a video (compact disc which can be construed as a video) carried in the second cavity. See Figure 2 embodiment and column 2, lines 58-63.

The compact disk can contain video games and the book can have related information for the video game. Therefore the fold open display box of Blanco '575 Contains a toy (booklet) and a video (it is well known to store videos on compact discs).

The fold open display box of Blanco '575 is for storing compact disks, floppy disks and a booklet. The compact disks can include any type of software including children's video games and video stories and the book can have material corresponding the characters of the video. Official notice is taken that it is old and conventional to make a book in the shape of a character in the book. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the book have the shape of a character depicted in the video and the book.

With respect to claims 52 and 55 and the shape of the cut out portion, it would have been an obvious matter of design choice to modify the shape of the cut out in the foldable case to match the items being held therein in order to provide better viewing of the item therein, since such a modification would have involved a mere change in the shape of a component. A change in the shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Alternatively, it is well established that the meaning or form, *per se*, of claimed printed matter/descriptive subject matter/recorded matter may not be given patentable weight when it does not establish a new relationship with respect to the underlying substrate. See MPEP 2112.01(III); See In re Gulack, 703 F.2d. 1381 [217 USPQ 401, 403] (Fed. Cir. 1983), See In re Ngai, 70 USPQ2d 1862,1864 (CAFC 2004).

Furthermore it is well know to provide character figures corresponding to a character depicted in the recorded media. One does not need to go any further than the Disney video recorded media and the character figures in the shape of three dimensional figures, which are created and correspond to the characters in the video recorded media.

3. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blanco '575 in view of Farrell (5,464,253). Blanco '575 as described above discloses all the limitations of the claim except for the toy including a sound generator. Farrell '253 discloses that it is desirable to make booklets from pressable material to provide a delightful animation in the form of a squirt of water related to the story. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the booklet of Blanco '575 from a pressable material as taught by Farrell '253 to provide a delightful animation in the form of a squirt of water related to the story. The squirt nozzle (9) will inherently generate a sound when ejecting the water.

4. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Blanco '575 and further in view of Paige (3,641,684). Blanco '575 as described above discloses all the limitations of the claims except for the box including a loudspeaker for

generating sound related to a toy in the box. Paige '684 discloses a box having a loudspeaker for generating sound related to a toy (book and cassette) in the box. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a loudspeaker in the box of Blanco '575 as taught by Paige '684 to generate sound related to a toy (book and cassette) in the box.

Response to Arguments

5. Applicant's arguments filed November 22, 2005 have been fully considered but they are not persuasive. The shape of the character can be a book in the shape of a square. A book can be construed as a three dimensional figure.

Conclusion

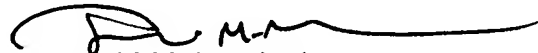
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
June 08, 2006